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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

COSIMANO, EDWARD R

ART UNIT PAPER NUMBER

3629

DATE MAILED: 01/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/378,514

Applicant(s)

MYRICK ET AL.

Examiner

Edward R. Cosimano

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 2-12 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 October 0203 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

1. Applicant should note the changes to patent practice and procedure:
  - A) effective December 01, 1997 as published in the Federal Register, Vol 62, No. 197, Friday October 10, 1997;
  - B) effective November 07, 2000 as published in the Federal Register, Vol 65, No. 54603, September 08, 2000; and
  - C) Amendment in revised format, Vol. 1267 of the Official Gazette published February 25, 2003.
2. The disclosure is objected to because of the following informalities:
  - A) the following errors have been noted in the specification:
    - (1) pages 79-80 contain illustrations which are forbidden by 37 CFR § 1.58(a).

Appropriate correction is required.

3. The specification and drawings have not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification or drawings. Applicant should note the requirements of 37 CFR § 1.74, § 1.75, § 1.84(o,p(5)), § 1.121(a)-1.121(f) & § 1.121(h)-1.121(i).
4. 35 U.S.C. § 101 reads as follows:

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title".
- 4.1 Claims 2-12 are rejected under 35 U.S.C. § 101 because the invention as claimed is directed to non-statutory subject matter.
- 4.1.1 Although the instant claims recite:
  - 1) a method, (claims 2-11), which has a practical application in the technological arts, and
  - 2) which does not define either a computer program, a data structure, non-functional descriptive material, (i.e. mere data) or a natural phenomenon,

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the instant claims merely define a series of steps that as claimed may or may not be performed on a computer and which merely define types of data to be manipulated.

4.1.2 In regard to claims 2-11, the invention as set forth in these claims merely describe the steps of:

- A) collecting of data (lines 4-5 of claim 2);
- B) organizing the collected data (lines 6-8 of claim 2);
- C) using common terminology to describe the collected data (lines 9-10 of claim 2);
- D) analyzing the information technology requirements (lines 11-12 of claim 2);
- E) planning for the implementation of the information technology requirements (lines 13-14 of claim 2); and
- F) describe various types of data (lines 15-19 of claim 2);

however, as recited in these claims none of the above steps/actions are tangibly used in a concrete manner so as to produce a concrete and tangible result with in the technological arts.

4.1.3 In regard to claim 12, the invention as set forth in these claims merely describes a data structure and the various types of data with in the structure, however, as recited in these claims the described data structure is tangibly implemented or used in a concrete manner so as to produce a concrete and tangible result with in the technological arts.

4.1.4 It is further noted that applicant has not claimed a specific process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, which is either altered or changed or modified by the invention recited in claims

4.1.5 It is further noted that applicant has not claimed either:

A) pre computer processing, since the claims fail to recited that the data, which originates from an unknown source, is manipulated or changed before it is processed, or

B) post computer processing, since the claims fail to recited that the data which represents the result of the claimed manipulation is either manipulated or used or changed by any device after it has been processed.

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4.1.6 In view of the above, the invention of claims 2-11 merely manipulates the abstract idea of the creation of a data structure, i.e. matrix, and filling the data structure.

4.1.7 In view of the above, it is further noted that the invention of claims 2-11 lacks a claimed practical application since the claimed invention, either:

A) does not have the functionality required to carry out the recited steps or functions of the claimed invention; or

B) is not used by any system or device or method outside of the claimed invention,

in a concrete and tangible manner, (note In re Beauregard 35 USPQ2d 1383 (CAFC 1995) and the associated claims of U.S. Patent 5,710,578; and State Street Bank & Trust Co. v. Signature Financial Group Inc. 47 USPQ2d 1596 (CAFC 1998)).

4.1.8 It is further noted that the type/nature of either the data or the calculated numbers does not affect the operation of the claimed invention and hence are considered to be non function descriptive material, (note In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983)).

4.1.9 Hence, claims 2-11 are directed to non-statutory subject matter.

4.1.10 The instant claims recite a system/device, (claim 12), which has a practical application in the technological arts, and which does not merely define either a computer program, a data structure, non-functional descriptive material, (i.e. mere data) or a natural phenomenon. Hence, the instant claims merely define device that contains a series of steps that could be but are not necessarily to be performed on a computer.

4.1.11 It is further noted that applicant has not recited a specific machine since the operations recited in the claim are merely to illustrate the operations of the instant invention since these operations are not in fact implemented by a processor/computer. Hence, applicant envisions the invention as recited in claim 12 as a disembodied storage device, i.e. memory, that stores a computer program as a non-functional data structure. Such a disembodied storage device is not a specific machine because:

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A) it is not associated with a computer in such a way as to cause the computer to operate in a specific manner, (note In re Beauregard 35 USPQ2d 1383 (CAFC 1995) and the associated claims of U.S. Patent 5,710,578); and

B) a memory alone can not perform the functions recited within the claims.

Therefore, the recited disembodied storage device, which itself can not perform the functions recited within the claims as the invention, is inoperative and lacks utility for the purpose of the invention.

4.1.12 In view of the above, the invention recited in claim 12, merely describes an abstract idea of a disembodied storage device, i.e. memory, that stores a computer program as a non-functional data structure, since a disembodied storage device by itself can not produce a concrete and tangible result by performing the functions recited within the claims as the invention (State Street Bank & Trust Co. v. Signature Financial Group Inc. 47 USPQ2d 1596 (CAFC 1998)). Hence, claim 12 does not have a claimed practical application, since the disembodied storage device is inoperative and therefore lacks utility for the purpose of the invention.

4.1.13 Nonfunctional descriptive material cannot render nonobvious an invention that would have otherwise been obvious. Cf. In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability). Common situations involving nonfunctional descriptive material are:

- a computer that differs from the prior art solely with respect to nonfunctional descriptive material that cannot alter how the machine functions (i.e., the descriptive material does not reconfigure the computer), or
- a process that differs from the prior art only with respect to nonfunctional descriptive material that cannot alter how the process steps are to be performed to achieve the utility of the invention.

4.1.14 Hence, claim 12 is directed to non-statutory subject matter.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR § 1.136(a).

5.1 A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR § 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Response to applicant's arguments.

6.1 All rejections and objections of the previous Office action not repeated or modified and repeated here in have been over come by applicant's last response.

6.2 As per the remaining objection, since the amendment filed May 22, 2003 to pages 79-80 is improper since it failed to provide specific instructions as to what is to be added or cancelled, applicant should resubmit this amendment.

6.3 As per the 35 U.S.C. § 101 rejection, since:

A) the invention as recited in claims 2-11 does not generate a concrete and tangible result because the claims merely manipulate information/data that is neither externally used or manipulated by the invention and hence these claims merely manipulate an abstract idea which as claimed is not tied to the physical world in such a manner as to produce a concrete and tangible result in the technological arts.

B) the invention as recited in claim 12 does not generate a concrete and tangible result because:

(1) the claims recite functional language that can not be implemented in a physical manner, since a computer readable medium clearly can not perform the functions recited in claim 12; and

(2) even if the function language was to be implemented, then claim 12 would merely recite functional language that is intended to manipulate information/data that is neither externally used or manipulated by the invention.

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Hence this claim merely manipulates an abstract idea which as claimed is not tied to the physical world in such a manner as to produce a concrete and tangible result in the technological arts.

Hence, applicant's argument's are non persuasive.


7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward Cosimano whose telephone number is (703) 305-9783. The examiner can normally be reached Monday through Thursday from 7:30am to 6:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss, can be reached on (703)-308-2702. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

7.1 The fax phone number for UNOFFICIAL/DRAFT FAXES is (703) 746-7240.

7.2 The fax phone number for OFFICIAL FAXES is (703) 872-9306.

7.3 The fax phone number for AFTER FINAL FAXES is (703) 872-9306.

01/20/04

  
Edward R. Cosimano  
Primary Examiner A.U. 3629